

REMARKS/ARGUMENTS

In the Non-Final Office Action of June 30, 2006 (the "Office Action"):

1. Claims 1-19 and 49-52 are rejected under 35 U.S.C. 112, 2nd paragraph; and
2. Claims 1-19 and 49-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,090,107 issued to Borgmeier et al. ("Borgmeier") in view of U.S. Pat No. 5,496,315 issued to Weaver et al. ("Weaver").

1. **Rejection of Claims 1-19 and 49-52 under 35 USC 112, 2nd paragraph:**

Claims 1-19 and 49-52 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, it is asserted in the Office Action that the independent claims both include language toward an insulative sleeve that inhibits conduction of electrical current flowing from the electrode to the electrosurgical instrument, and that the word "surface" (referring to the longitudinal surface of the instrument) inserted just prior to the claimed phrase "conduction of electrical current" would rectify this indefiniteness.

Independent claims 1 and 49 have been amended as suggested in the Office Action to insert the word "surface" just prior to the claimed phrase "conduction of electrical current", and with such amendment, the rejection of these claims under 35 U.S.C. 112, 2nd paragraph, is believed to be overcome.

If is further asserted in the Office Action that claim 16 includes the non-sensical phrase, “and one of the at least one internal sealing ring”, and that amendment of such is required.

Claim 16 has been amended so that the objected to phrase now reads “and at least one of the pair of internal sealing rings”, and with such amendment, the rejection of this claim under 35 U.S.C. 112, 2nd paragraph, is believed to be overcome.

2. Rejection of Claims 1-19 and 49-50 under 35 USC 103(a):

Claims 1-19 and 49-50 are rejected in the Office Action as being unpatentable under 35 U.S.C. 103(a) over Borgmeier in light of Weaver.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Also, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A case for *prima facie* obviousness has not been established against the claims, because neither of the cited references, alone or in combination, teaches or suggests the insulative rigid sleeve in which a pair of internal sealing rings is compressed against inner distal and proximal ends of the insulative rigid sleeve, as claimed in claims 1 and 49. See, e.g., sealing rings 172 placed within distal and proximal ends of end-effector sleeve 102 in FIG. 6B of the application.

Although Borgmeier shows an insulating sheath 61 that is electrically insulative and arguably disposed around an electrode 56, it is not rigid. Borgmeier's sheath 61 is made from a "flexible medical grade elastomer." See, e.g., Col. 5, lines 10-11 of Borgmeier. Also, Borgmeier's electrosurgical instrument does not have any internal sealing rings.

In Weaver, an insulating coating or sleeve 13 is shown disposed over a blade 12 and a single "O" ring 19 disposed within a distal end of a pencil 16. See, e.g., FIG. 1 and corresponding description in Col. 2, lines 25-46 of Weaver. The "O" ring 19 compresses against the outer surface of the sleeve 13 to form a tight seal that prevents fluid from progressing inward into the interior of the pencil 16. See, Col. 3, lines 5-14. Since the rigidity and insulative properties of Weaver's pencil 16 are not disclosed, and only a single "O" ring 19 is shown, Weaver also fails to teach an insulative rigid sleeve and pair of internal sealing rings as claimed in applicants' claims.

As well as failing to individually teach or suggest applicants' insulative rigid sleeve and pair of internal sealing rings that is compressed against inner distal and proximal ends of the insulative rigid sleeve, as claimed in claims 1 and 49, the combination of Borgmeier and Weaver also fails to teach or suggest such elements.

First of all, placing an "O" ring on the distal end of Borgmeier's "insulation layer" 60 (and therefore, within the distal end of the "sleeve" 61) would not work properly, because there is a slot 70 that makes the outer surface of the "insulation layer" 60 discontinuous. Therefore, the "O" ring would leak in such a placement in Borgmeier's electrosurgical instrument, which would absolutely defeat its purpose.

Although an "O" ring might be placed on the neck portion 54 of Borgmeier's "electrode" 56 (and therefore, also within the distal end of the "sleeve" 61), the seal integrity would be questionable in such case since Borgmeier's "sleeve" 61 is a flexible elastomer. It is well known that to have an "O" ring work consistently for sealing purposes, it needs to be compressed a predictable amount each time. With a flexible sleeve, the amount of compression applied against the "O" ring would vary and the seal may not work. A similar problem would be encountered if an "O" ring were to be placed on insulating material 38 in an attempt to seal the proximal end of Borgmeier's "sleeve" 61.

Accordingly, Claims 1 and 49 are believed to be patentable under 35 U.S.C. 103(a) over Borgmeier in view of Weaver, for the foregoing reasons.

Claims 2-19 and 50 are also believed to be patentable under 35 U.S.C. 103(a) over Borgmeier in view of Weaver since they depend from claims 1 or 49, and as such, are believed to be patentable for at least the same reasons as stated in reference to claims 1 and 49. Further, although spring tabs, latching members, gripping members, electrical tabs, and two sealing rings may be individually known, it is the combination of the elements being claimed in the claims that determines patentability.

Claims 51 and 52 have been canceled since their respective limitations have been added into corresponding of claims 1 and 49.

Conclusion

Claims 1-19 and 49-50 are pending in the application. Claims 20-48 and 51-52 have been canceled without prejudice. Reconsideration of the rejected claims is respectfully

requested in light of the amendments and arguments set forth herein, and an early notice of their allowability earnestly solicited.

Respectfully submitted,

Dated: August __, 2006



Victor Okumoto

Registration No. 35973

Office Phone: (408) 523-2129